

Based on the Examiner's withdrawal of rejections relying on Jenkins under 35 U.S.C. §102, it has apparently been agreed that Jenkins fails to teach all the claimed elements. Among the failures of Jenkins to teach all the claimed elements of the claimed invention is the claimed talc content. Specifically, the composition of Jenkins, comprises **at least 1.05 part of talc per 100 parts by weight HDPE**. This minimum value results from the maximum polyethylene content, 95 weight percent, and the minimum filler weight content, 1 weight percent, as $1/95 \times 100$. Jenkins is, therefore, in contrast to the claimed invention, which, according to Claim 1, comprises "**talc in an amount less than 1 part per 100 parts by weight polyethylene.**"

To overcome the failures of Jenkins, the Office Action suggests that, apparently not withstanding the absence of an overlap of the ranges, "Since Jenkins et al. teach talc merely used as a filler, it would have been obvious to one having ordinary skill in the art to have used less filler if e.g. manufacturing costs were not an issue." Page 4, second paragraph. However, this argument is problematic for at least the following reasons.

First, the suggested modification of Jenkins apparently relies on impermissible hindsight based on the disclosure of the present application; in the present application it has been determined that talc in the claimed range unexpectedly enhances creep resistance. See Examples, Table I, and page 8, ln 1-5. The possibility that manufacturing costs are not an issue is not suggested by Jenkins. Accordingly, since no other motivation is cited by the Office Action and since Jenkins lacks any such motivation, the only possible basis for the asserted motivation is impermissible hindsight.

Second, Jenkins provides the opposite motivation to that suggested in the Office Action. That is, the apparent motivation of Jenkins is to use "fillers" to reduce

manufacturing costs. In other words, Jenkins teaches away from the suggested modification and, accordingly, fails to establish a *prima facie* case of obviousness against the claimed invention.

Third, even if the suggested modification was supported by a reference, one skilled in the art would still not find the claimed invention obvious based on the disclosure of Jenkins. Specifically, as suggested by the Office Action, if manufacturing costs were not an issue, one skilled in the art relying on Jenkins would not use talc at all. Accordingly, because the proposed modification would render Jenkins unsatisfactory for its intended purpose due to the absence of filler, there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Furthermore, in this light, Jenkins would be read not to have any talc and, thereby, would not teach or suggest the claimed range.

Fourth, even if the modification of Jenkins was within the skill of the art, this is not sufficient to establish a *prima facie* case of obviousness without some objective reason to modify the teachings of the reference. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat.App. & Inter. 1993).

For at least the reasons above, the rejections of claims 1-9 and 15 are traversed. In addition, the following claims are believed to be independently allowable.

With respect to Claim 2, Jenkins teaches talc generally as a filler but does not teach or suggest that the talc has a lamellar texture.

With respect to Claim 4, Jenkins does not teach or suggest that the amount of talc is between 0.05 and 0.25 parts per 100 parts by weight of polyethylene.

With respect to Claim 7, Jenkins does not teach or suggest that the composition is extruded in the form of granules. Jenkins merely teaches that the “blended composition was pelletized” (Col. 2, ln 67) and then put into an extruder and extruded “to produce an oriented film.” (Col. 3, ln 3).

With respect to Claim 8, Jenkins only teaches the preparation of packing materials and films and does not teach or suggest shaped articles.

With respect to Claim 9, Jenkins does not teach or suggest extrusion or injection.

With respect to Claim 15, Jenkins does not teach or suggest talc in an amount which does not exceed 0.5 parts per 100 parts by weight of polyethylene.

With respect to Claims 16 and 17, Jenkins does not teach or suggest talc in an amount effective to increase a creep resistance.

2. Rejections under 35 U.S.C. §103 as obvious over Wooster.

The Applicants respectfully traverse the rejection of Claims 1 - 15 over Wooster alone under 35 U.S.C. 103.

Wooster does refer to the inclusion of additives in a molded material, specifically stating that:

Although generally not required, the molded material of the present invention can also contain additives to enhance antiblocking and coefficient of friction characteristics including, but not limited to, untreated and treated silicon dioxide, talc, calcium carbonate, and clay, as well as primary, secondary and substituted fatty acid amides, release agents, silicone coatings, etc. Still other additives, such as quaternary ammonium compounds alone or in combination with ethylene-acrylic acid (EAA) copolymers or other functional polymers, can also be added to enhance the antistatic characteristics of the polyethylene material of this invention. (Col. 14, lines 22-33.)

However, the reference in Wooster to the inclusion of talc is only a general one.

Accordingly, Applicants respectfully assert that Wooster fails to render the claimed invention obvious for at least the following reasons.

First, Wooster fails to provide any teaching or suggestion with respect to the selection of talc from the broad category of additives and the (infinitely) large number of identified compounds. Wooster teaches an open ended set of at least ten independent categories of additives for antiblocking and friction characteristics. Specifically, (1) untreated silicon dioxide, (2) treated silicon dioxide, (3) talc, (4) calcium carbonate, (5) clay, (6) primary fatty acid amides, (7) secondary fatty acid amides, (8) substituted fatty acid amides fatty acid amides, (9) release agents, and (10) silicone coatings. It is noted that at least categories (6) - (10) represent essentially unlimited numbers of components.

However, in order to establish a *prima facie* case of obviousness, some motivation to select among the (infinitely) large number of additives must be taught or suggested by the reference. See *In re Duel*, 51 F.3d 1552, 1558-9 (Fed. Cir. 1995). Wooster lacks any such motivation for selection and, accordingly, fails to render obvious the claimed invention. Wooster, rather than providing incentive, leads away in the sense that Wooster suggest there is no advantage in using talc in the Wooster polyethylene blends

Second, Wooster fails to teach or suggest a means for selecting the talc content of the claimed invention. The Office Action asserts that, based on Wooster, "it would have been obvious to one having ordinary skill in the art to have included the talc in an effective amount to have imparted antiblocking and coefficient of friction characteristics." Page 5, second paragraph. Assuming for the sake of argument that this statement is accurate, it is nevertheless irrelevant to the composition of the present

invention wherein the identification of the claimed talc range is based on the unexpectedly determined enhancement to creep resistance. See Examples, Table I, and page 8, lines 1-5. Accordingly, Wooster fails to render obvious the claimed invention.

Third, Wooster fails to teach or suggest the claimed range of talc. Thus, Wooster provides no enablement for the efficacious use of additives in the Wooster polyethylene bends nor enablement for applicants claimed composition. The Office Action asserts that “The determination of such [effective] amount of talc to impart such [antiblocking and friction] characteristics is deemed to be routine optimization and well within the level of skill of the ordinary artisan.” Page 5, second paragraph. However, as discussed above, Wooster’s teachings with respect to antiblocking and friction differ from the parameter of creep resistance on which the claimed range is based. Similarly, the statement in the Office Action that it would have been obvious to use “more or less of the talc additive if manufacturing costs were of an issue” is not relevant as the issue disclosed in the specification on which the claimed range is based is creep resistance. Moreover, the argument is essentially an ‘obvious to try’ rationale. Accordingly, the basis is impermissible to support a *prima facie* case of obviousness. See *In re O’Farrel*, 853 F.2d 894, 900 (Fed. Cir. 1986).

For at least the above reasons, the rejection of Claims 1-15 is respectfully traversed. In addition, the following claims are believed to be independently allowable.

With respect to Claim 2, Wooster does not teach or suggest that the talc has a lamellar texture.

With respect to Claim 3, Wooster does not teach or suggest the claimed size range of the talc.

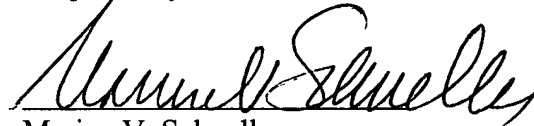
With respect to Claim 4, Wooster does not teach or suggest the claimed relative weight of the talc.

With respect to Claim 15, Wooster does not teach or suggest the claimed relative weight of the talc.

With respect to Claims 16 and 17, Wooster does not teach or suggest talc in an amount effective to increase a creep resistance.

Reconsideration and withdrawal of the pending rejections is respectfully solicited.

Respectfully submitted,



Marina V. Schneller

Reg. No. 26,032

VENABLE

P.O. Box 34385

Washington, D.C. 20043-9998

Telephone: (202) 962-4800

Telefax: (202) 962-8300

Enclosure

- Hungarian Patent Office Search Report (1-28-00)

MVS/MJF

DC2 217985